

Remarks

The examiner has rejected Claims 13-15 under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner asserts that Claims 13-15 are vague and indefinite in that it is not known what is meant by the nomenclature of the species.

Applicants respectfully disagree that Claims 13-15 are vague and indefinite and assert that Claims 13-15 as written comply with 35 U.S.C. §112, second paragraph. The examiner relied on two chemical nomenclature programs, ChemDraw and the program used by Chemical Abstracts, to define the nomenclature for the species of Claims 13-15. Reliance on these programs is not the proper standard. The nomenclature of the species of Claims 13-15 has been clearly defined in the specification. A patentee can choose to be his or her own lexicographer by “clearly setting forth an explicit definition for a claim term.” *Abbott Labs. v. Novopharm Ltd.*, 323 F.3d 1324, 1330 (Fed. Cir. 2003).

A claim is definite if the subject matter defined in the claims is described in the specification and the specification as a whole is such to enable one skilled in the art to make and use the claimed invention. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). The definiteness of the language must be analyzed not in a vacuum, but always in the light of the teachings of the prior art and the specification as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.* Claims, which on a first reading – in a vacuum – may appear indefinite become quite definite upon a reading of the specification or prior art. *Id.* at note 2.

The correlation of the name “6,7-dihydro-6H-[1,4]diazepino[6,7,1-hi]indole” with a structure is found on page 17 of the specification. Additionally, the structural element is clearly illustrated in Preparation 11, as shown below as Figure (1), on page 28 of the specification and named 6-(tert-butoxycarbonyl)-6,7-dihydro-6H-[1,4]diazepino[6,7,1-hi]indole.

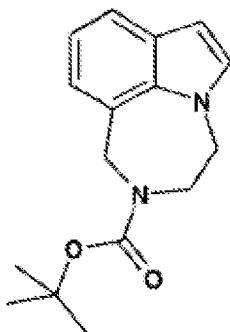


Figure (1)

Additionally, the numbering system associated with this ring system is clearly illustrated by the structures and nomenclature in the specification. Preparation 9, represented by Figure (2) below, is defined on page 25 of the specification and named 9-methyl-6-(*tert*-butoxycarbonyl)-6,7-dihydro-6H-[1,4]diazepino[6,7,1-hi]indole.

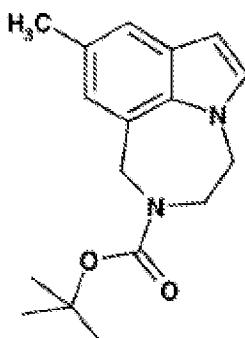


Figure (2)

Preparation 10, represented by Figure (3) below, is defined on page 28 of the specification and named 6-(*tert*-butoxycarbonyl)-5-methyl-6,7-dihydro-6H-[1,4]diazepino[6,7,1-hi]indole.

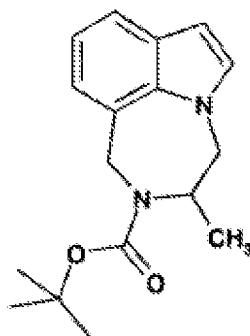


Figure (3)

Preparation 126, represented by Figure (4) below, is defined on page 61 of the specification and named 6-(*tert*-butoxycarbonyl)-7-methyl-6,7-dihydro-6H-[1,4]diazepino[6,7,1-hi]indole.

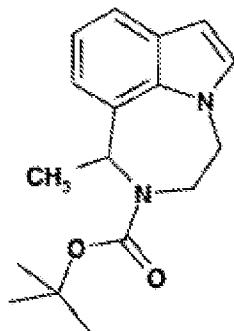


Figure (4)

The naming of this structural element clearly sets forth an explicit definition for the naming

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criteria of the species of Claims 13-15 and thus the correlation of the name to the structure. Therefore, one of ordinary skill in the art could easily and unambiguously correlate the structure of Figure (2) with the name provided for EXAMPLE 365, 3-(9-Fluoro-6-((piperidin-1-yl)carbonyl)-6,7-dihydro-[1,4]diazepino-[6,7,1-hi]indol-1-yl)-4-(imidazo[1,2-a]pyridine-3-yl)-2,5-dioxopyrrole, as claimed in Claims 13-15. See Figure (5) below.

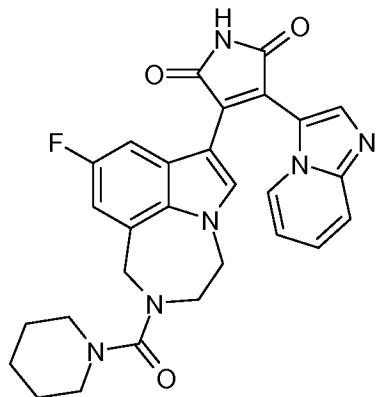


Figure (5)

Applicants respectfully assert that the specification clearly defines and informs the skilled artisan of the nomenclature of the species of Claims 13-15 and thus, complies with 35 U.S.C. §112, second paragraph. Withdrawal of the rejection and allowance of Claims 13-15 are respectfully requested.

Respectfully submitted,

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June 18, 2008